

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MAN WAH HOLDINGS LIMITED,  
Petitioner,

v.

RAFFEL SYSTEMS, LLC,  
Patent Owner.

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Case PGR2019-00029  
Patent D821,986 S

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Before GRACE K. OBERMANN, CHRISTOPHER G. PAULRAJ, and  
RYAN H. FLAX, *Administrative Patent Judges*.

FLAX, *Administrative Patent Judge*.

DECISION  
Institution of Post-Grant Review  
35 U.S.C. § 314

Raffel Systems, LLC (“Patent Owner”) is the owner of U.S. Patent No. D821,986 to Kenneth G. Seidl et al. (Ex. 1001, “the D’986 patent”), and is identified as the real-party-in-interest in this matter. Paper 7 (Patent Owner Mandatory Notices at 1 (Feb. 5, 2019)). Man Wah Holdings Limited (“Petitioner”) filed a Petition requesting post-grant review of the claim of the D’986 patent. Paper 3 (“Pet.”). Petitioner identifies itself as the real-party-in-interest here. Pet. 1. Patent Owner did not file a Preliminary Response.

Under 37 C.F.R. § 42.4(a), we have authority to determine whether to institute a post-grant review. We may institute a post-grant review if the information presented in the petition filed under 35 U.S.C. § 321, and any response filed under 35 U.S.C. § 323, shows that “it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable.”

35 U.S.C. § 324(a). After reviewing Petitioner’s as-yet-uncontested submissions, we conclude that Petitioner has demonstrated it is more likely than not that the claim challenged (there is only one) in the petition is unpatentable. Therefore, we institute post-grant review of the aforementioned claim on both grounds raised in the petition, pursuant to 35 U.S.C. § 324. *See SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018); *see also* Guidance on the Impact of SAS on AIA Trial Proceedings (April 26, 2018) (available at <https://www.uspto.gov/patents-application-process/patent-trial-and-appealboard/trials/guidance-impact-sas-aia-trial>).

## I. BACKGROUND

### A. RELATED MATTERS

Petitioner has disclosed, “[t]he '986 patent is presently at issue in the action titled *Raffel Systems, LLC v. Man Wah Holdings LTD Inc et al.*, Case

2:18-cv-01765 (WIED).” Pet. 1. Patent Owner identifies the same related matter. *See* Paper 4, 1.

*B. THE CLAIMED INVENTION*

The D’986 patent is a design patent and the invention is an “ornamental design for a switch, as shown and described” in the patent. Ex. 1001, claim. The D’986 patent includes six (6) drawings, reproduced below:

FIG. 1

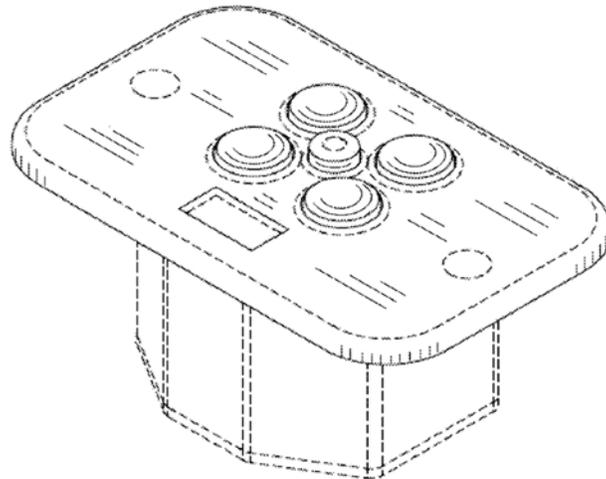


Figure 1, above, shows a perspective view of the claimed switch design from above, looking over one rounded corner.

FIG. 5

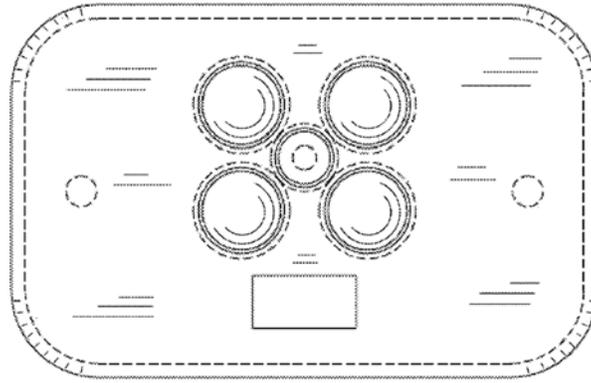


Figure 5, above, shows a top view of the claimed switch design.

FIG. 2

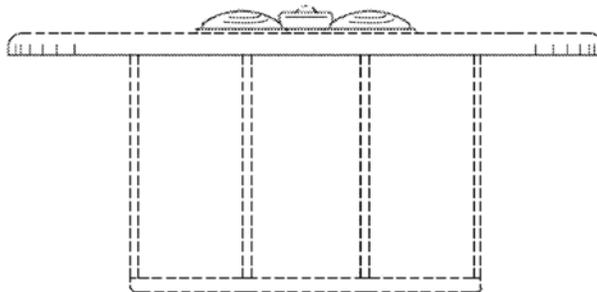


Figure 2, above, shows a side view of the claimed switch design, along a longer edge of the switch.

FIG. 3

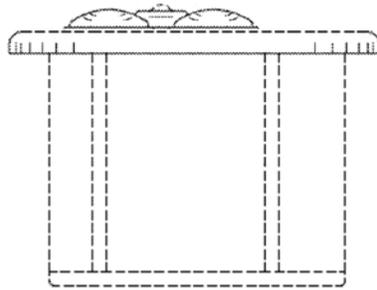
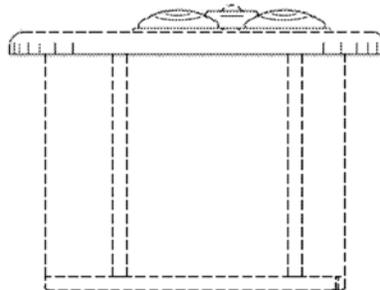


FIG. 4



Figures 3 and 4, above left and right, respectively, each show side views of the claimed switch design along shorter edges of the switch; Figure 3 showing the switch from one end and Figure 4 showing the switch from the opposite end.

FIG. 6

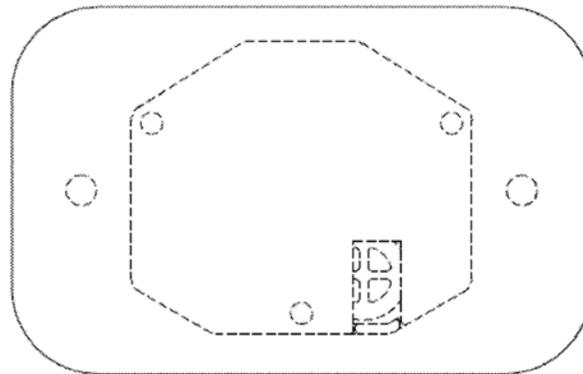


Figure 6, above, shows a bottom view of the claimed switch design.

The D'986 patent indicates it was filed as U.S. patent application serial number 29/592,595 on January 31, 2017. Ex. 1001. No other date for priority is indicated on the face of the D'986 patent. *Id.* Petitioner contends

this is, therefore, the priority date for the D’986 patent against which prior art is measured. Pet. 3.

*C. PETITIONER’S ASSERTED GROUNDS FOR UNPATENTABILITY*

Petitioner asserts two (2) grounds for unpatentability, one under 35 U.S.C. § 102(a)(1) for anticipation and the other 35 U.S.C. § 103 for obviousness. Pet. 3, 23–32. Petitioner’s grounds are as follows:

**Ground 1:** the claim is unpatentable under 35 U.S.C. § 102(a)(1) over Raffel\_sample<sup>1</sup>;

**Ground 2:** the claim would have been obvious under 35 U.S.C. § 103 over Kintec Solution<sup>2</sup> in view of Hua-Dali;<sup>3</sup>

*Id.*

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<sup>1</sup> Nov. 17, 2015 email from “Ben Song <bsong@raffel.com>” to “Manwah-Manager Chen <chenjj@manwahgroup.com>; Manwah-Huang Linhua <307429367@qq.com>; [and] Paul Stangl <pstangl@weimerbearing.com>,” and copying “Richard Weeden <rweeden@raffel.com>; Ken Seidl <kseidl@raffel.com>,” including a PDF file attachment titled “Power Recline and Headrest by Paul 11.16.15.pdf.” (Ex. 1004, “Song email” and Ex. 1005 “Song email” (English Translation)). The PDF attachment includes a product Petitioner identifies as “Raffel\_sample.”

<sup>2</sup> EUIPO Design Registration 001863556-0004 (registered and published June 6, 2011) (Ex. 1006, “Kintec\_Solution”). We note Exhibit 1006 is labeled “Man Wah Exhibit 1005” in its lower right corner; however, we understand this to be Exhibit 1006 and will refer to it as such.

<sup>3</sup> CN Industrial Design Registration 303948579 (published Nov. 30, 2016) (Ex. 1007, “Hua-Dali”).

In support of these grounds for unpatentability, Petitioner submitted, *inter alia*, a Declaration of Linhua Huang<sup>4</sup> and a Declaration of Mingshao Zhang.<sup>5</sup>

## II. DISCUSSION

### A. *ORDINARY LEVEL OF SKILL IN THE ART*

Petitioner contends “[a] Designer Having Ordinary Skill In The Art (DHOSITA) would generally have had either (i) a degree in Industrial Engineering or Mechanical Engineering who has taken product design courses or (ii) two years of work experience creating industrial designs.” Pet. 16 (citing Zhang Declaration, Ex. 1011 ¶ 20). Patent Owner has not, as yet, disputed Petitioner’s definition of the skilled designer or provided a different definition. Petitioner’s definition of the designer’s level of ordinary skill in the art is supported by the Zhang Declaration. Ex. 1011 ¶ 20. Therefore, at this stage in the proceedings, we accept and use Petitioner’s definition of the skilled designer.

### B. *CLAIM CONSTRUCTION*

Based on the filing date of the Petition (Dec. 14, 1028), the Board interprets claim terms in a post-grant review (“PGR”) using the same claim construction standard that is used to construe claims in a civil action in

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<sup>4</sup> Declaration of Linhua Huang (Ex. 1010, “Huang Declaration”). Mr. Huang authenticates the Song email (Exs. 1004 and 1005) and its attachment as true and correct copies and received by him on November 17, 2015. *Id.* ¶¶ 3–5.

<sup>5</sup> Declaration of Mingshao Zhang in Support of Man Wah Holdings Limited’s Petition for Post Grant Review of U.S. Patent No. D821,986 (Ex. 1011, “Zhang Declaration”).

federal district court. *See* 83 Fed. Reg. 51,340 (Nov. 13, 2018) (to be codified at 37 C.F.R. pt. 42).

The claim of the D’986 patent does not require express construction for the purposes of this decision. On that point, we observe that Figures 1–6 of the D’986 patent (Ex. 1001) reflect the scope of the patented design. To the extent any explanation of that scope is necessary to this decision, we provide it below in our analysis of the asserted challenge. *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co. Ltd.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (“we need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy’” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

C. *LEGAL STANDARDS FOR ANTICIPATION AND OBVIOUSNESS*

The Leahy–Smith America Invents Act (AIA) bars a person from receiving a patent on an invention that was “in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention.” 35 U.S.C. § 102(a)(1). When considering whether a claimed design is anticipated over a prior art disclosure the factual inquiry is the same as in utility patent applications, that is, the reference “must be identical in all material respects,” or put another way, the claimed design and the prior art design must be substantially the same. *Hupp v. Siroflex of America Inc.*, 122 F.3d 1456 (Fed. Cir. 1997); *Door-Master Corp. v. Yorktowne, Inc.*, 256 F.3d 1308, 1313 (Fed. Cir. 2001) (citing *Gorham Mfg. Co. v. White*, 81 U.S. 511, 528 (1871)). A printed publication can anticipate a patent’s claim and our reviewing court has interpreted Section 102

. . . in light of its purpose “to prevent withdrawal by an inventor  
. . . of that which was already in the possession of the public.”

*Medtronic, Inc. v. Barry*, 891 F.3d 1368, 1380 (Fed. Cir. 2018) (alteration in original) (quoting *In re Wyer*, 655 F.2d 221, 226 (CCPA 1981)). “Because there are many ways in which a reference may be disseminated to the interested public, ‘public accessibility’ has been called the touchstone in determining whether a reference constitutes a ‘printed publication’ . . . .” *In re Hall*, 781 F.2d 897, 898–99 (Fed. Cir. 1986). A reference is considered publicly accessible “upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it.” *Wyer*, 655 F.2d at 226. “If accessibility is proved, there is no requirement to show that particular members of the public actually received the information.” *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1569 (Fed. Cir. 1988).

*Jazz Pharmaceuticals, Inc. v. Amneal Pharmaceuticals, LLC*, 895 F.3d 1347, 1355–56 (Fed. Cir. 2018). Public accessibility to online material is sufficient for such material to be a “printed publication.” *Id.* at 1356–60.

The “on-sale” bar under Section 102 applies to design patents.

*Continental Plastic Containers v. Owens Brockway Plastic Products, Inc.*, 141 F.3d 1073, 1077 (Fed. Cir. 1998). The Supreme Court has held that

the pre-AIA on-sale bar applies “when two conditions are satisfied” more than a year before an inventor files a patent application. *Pfaff [v. Wells Electronics, Inc.]*, 525 U.S. [55], at 67 . . . [(1998)]. “First, the product must be the subject of a commercial offer for sale.” *Ibid.* “Second, the invention must be ready for patenting,” which we explained could be shown by proof of “reduction to practice” or “drawings or other descriptions of the invention that were sufficiently specific to enable a person skilled in the art to practice the invention.” *Id.*, at 67–68 . . . .

*Helsinn Healthcare S.A. v. Teva Pharma. USA, Inc.*, 139 S. Ct. 628, 633 (2019). The AIA has done away with the statutory language requiring that

the offer for sale be in the United States, but, otherwise, the AIA did not alter the meaning of the “on sale” bar from pre-AIA law. *Id.* “[A] commercial sale [triggering the on-sale bar] is one that bears the general hallmarks of a sale pursuant to Section 2-106 of the Uniform Commercial Code,” which states that “[a] ‘sale’ consists in the passing of title [i.e., ownership,] from the seller to the buyer for a price.” *Medicines Company v. Hospira, Inc.*, 827 F.3d 1363, 1365 (Fed. Cir. 2016); U.C.C. § 2-106 (AM. LAW INST. & UNIF. LAW COMM’N 2012).

The test for anticipation is the *Ordinary Observer Test*. *Int’l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233 (Fed. Cir. 2009). Two designs are substantially the same under the ordinary observer test if, in the eye of an ordinary observer, giving such attention as a purchaser usually gives and being familiar with prior art designs, the resemblance is such as to deceive such an observer, inducing her to purchase one supposing it to be the other. *Gorham*, 81 US 511; *Richardson v. Stanley Works*, 597 F.3d 1295 (Fed. Cir. 2010). The ordinary observer test requires consideration of the design as a whole. *See Int’l Seaway*, 589 F.3d at 1243; *Egyptian Goddess Inc. v. Swissa Inc.*, 543 F.3d 665, 677 (Fed. Cir. 2008).

Turning to obviousness, “[i]n determining the patentability of a design, it is the overall appearance, the visual effect as a whole of the design, which must be taken into consideration.” *See In re Rosen*, 673 F.2d 388, 390 (CCPA 1982). The proper standard is whether the design would have been obvious to a designer of ordinary skill who designs articles of the type involved, and it is from this “designer of ordinary skill” perspective, as

opposed to anticipation's ordinary observer, from which obviousness is determined. *See In re Nalbandian*, 661 F.2d 1214, 1217 (CCPA 1981).

To make out a successful obviousness challenge, one must identify “a reference, a something in existence, the design characteristics of which are basically the same as the claimed design . . . . Such a reference is necessary whether the holding is based on the basic reference alone or on the basic reference in view of modifications suggested by secondary references.” *Rosen*, 673 F.2d at 391. Accordingly, “the first step in an obviousness analysis for a design patent requires a search of the prior art for a primary reference,” which requires the tribunal “to: (1) discern the correct visual impression created by the patented design as a whole; and (2) determine whether there is a single reference that creates ‘basically the same’ visual impression.” *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996). Obviousness may be concluded if a designer of ordinary skill would have been motivated to modify such a primary reference by modifying, adding, or deleting features thereof in view of a pertinent secondary reference.

In order for secondary references to be considered in an obviousness analysis, there must be some suggestion in the prior art to modify the basic design with features from the secondary references. *See In re Borden*, 90 F.3d 1570, 1572 (Fed. Cir. 1996). The long-standing test for properly combining references has been “whether they are so related that the appearance of certain ornamental features in one would suggest the application of those features to the other.” *See In re Glavas*, 230 F.2d 447, 450 (CCPA 1956).

With these standards in mind, we address the challenges below.

*D. GROUND 1—UNPATENTABILITY UNDER 35 U.S.C. § 102  
OVER RAFFEL\_SAMPLE*

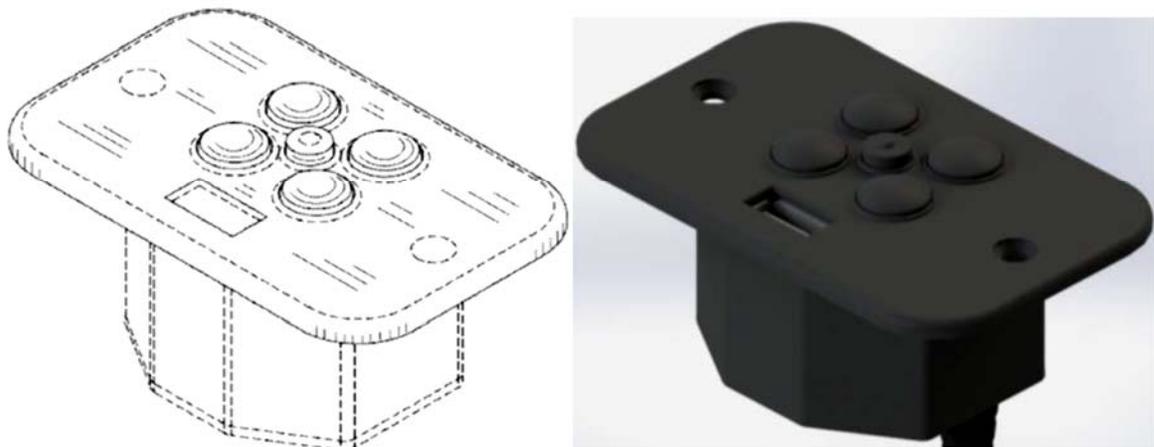
*Parties' Positions*

Petitioner contends:

Raffel\_sample anticipates the ornamental design claimed in the '986 patent because it discloses the each and every element of the design claimed in the '986 patent including: (a) a four-sided surface with four corners rounded; (b) four rounded buttons; (c) a rounded central component in the middle of the four rounded buttons; and (d) a rectangular hole away from the four-button group. Demonstratives showing where elements (a), (b), (c) and (d) are located in both Raffel\_sample and in the '986 patent are provided in the sections below.

Pet. 23 (citing Ex. 1011 ¶ 45). Petitioner further provides the following side-by-side comparison between Figure 1 of the D'986 patent and an image of a product reproduced from the PDF attachment to the Song email (Ex. 1004), which Petitioner calls "Raffel\_sample":

FIG. 1



The image above-left shows Figure 1 from the D'986 patent and the image above-right shows a product from the PDF attachment to the Song email, which the PDF attachment identifies as "Rectangular 5-Button Power Recline and Headrest with USB and Home Button" and Raffel P/N (product number) "CTR UR2 08." Regarding the above side-by-side image comparison, Petitioner states, "[a]s shown above, each and every element of the design claimed in '986 patent is present in Raffel\_sample. Ex. 1011, ¶ 45. Thus, Raffel\_sample anticipates the '986 patent." Pet. 24.

In discussing the Raffel\_sample, Petitioner's declarant, Zhang, states:

It is my understanding that, on November 17, 2015, Raffel's wholly owned subsidiary Xiamen Raffel communicated an offer via email to sell products to Man Wah. As stated in the November 17, 2015 email, a document is attached to the email. In the attached document of the November 17, 2015 email, Raffel\_sample is included. It is stated in the attached document that "[t]hese documents are available on [www.raffel.com](http://www.raffel.com)."

Ex. 1011 ¶ 25. The Zhang Declaration then goes on to reproduce and annotate portions of the Song email's PDF attachment, as shown below:

### ManWah - Power Recline and Headrest Controls

November 16, 2015

<u>Item</u>	<u>Raffel P/N</u>	<u>Price</u>	<u>VAT</u> <u>(17%)</u>	<u>RMB &amp;</u> <u>VAT</u>	<u>Min</u> <u>Qty</u>	<u>Total</u> <u>Price</u>	<u>** Delivered Pricing**</u>
Rectangular 5-Button Power Recline and Headrest with Home Button <small>Available in black or silver finish.</small>	CTR R2 04	47.02	7.99	55.01	1	55.01	
Rectangular 5-Button Power Recline and Headrest with USB and Home Button <small>Available in black or silver finish.</small>	CTR UR2 08	57.49	9.77	67.26	1	67.26	

All sales are subject to Raffel System's (I) standard terms and conditions of sale a  
**These documents are available at [www.raffel.com](http://www.raffel.com).**  
NOTE: Small quantities of all items are available on demand. If large quantities are needed,  
Changes to product specifications will result in price modifications.

*Id.*; see also Ex. 1004. The image above shows the same Raffel\_sample image as reproduced above along with the identifying text noted above. The above image also indicates that the “[a]ll sales are subject to Raffel System’s (I) standard terms and conditions of sales” and “[t]hese documents are available at [www.raffel.com](http://www.raffel.com).”

The Zhang Declaration goes on to state:

It is my understanding and as shown above, Raffel offers to sell Man Wah the highlighted Raffel\_sample product. The offer includes the product description, price and taxes. Additionally, it is stated in the attached document that “[t]hese documents are available on [www.raffel.com](http://www.raffel.com).” No passwords

and/or special links are provided in the attached document for accessing [www.raffel.com](http://www.raffel.com), thus, in my opinion, [www.raffel.com](http://www.raffel.com) can be publicly accessible. Therefore, Raffel\_sample is on sale to the public at least on November 17, 2015, which is fourteen (14) months before January 31, 2017 for the '986 patent.

Ex. 1011 ¶ 26. The Zhang Declaration goes on to state:

In my opinion and as shown in the attached document in the November 17, 2015 email, Raffel\_sample is a control for power recline and headrest of a sofa. In my opinion and as shown in the attached document in the November 17, 2015 email and is reproduced below, Raffel\_sample has five buttons and a central component. Raffel\_sample also has a rectangular hole on the surface used for a universal serial bus (USB) charging port. The buttons, the central component, the rectangular hole for USB charging port are all are sitting on a four-sided surface with four corners rounded.

and further states:

In my opinion and as shown above, four buttons of Raffel\_sample have a similar size and shape and are arranged in a cluster to form a rectangular shape. One central component is positioned in the middle of the cluster formed by the four buttons and has a smaller size relative to the size of the four buttons. The Raffel\_sample surface has a rectangular hole that is positioned away from the button group.

*Id.* ¶¶ 27–28.

As noted above, Patent Owner has not provided a substantive response to Petitioner's contentions at this stage in the proceedings.

#### *Analysis*

Although it is apparent Petitioner's Ground 1 presents a case under 35 U.S.C. § 102(a)(1), it is somewhat unclear whether Petitioner intends for this ground for unpatentability to be premised upon classical anticipation over a prior art publication, or upon the on-sale bar, or upon both. The

Petition states the ground as “The Claim Is Anticipated by Raffel\_sample” and presents evidence that the Raffel\_sample was described in a publically available, prior art publication; however, the Petition also identifies the Raffel\_sample as “Certified Raffel’s on sale product” and appears to contend that Patent Owner offered to sell the Raffel\_sample to Man Wah on November 17, 2015, and presents evidence to support the contention, but never explicitly argues the on-sale bar provision of Section 102. *See* Pet. 2–3, 8–11, 23–24; Ex. 1004; Ex. 1005; Ex. 1010 ¶¶ 1–5 (Huang Declaration authenticating Exs. 1004/1005 and describing facts supporting an offer for sale by Patent Owner to Petitioner); Ex. 1011 ¶¶ 25–28, 45 (Zhang Declaration supporting contentions of anticipation and offer for sale).

A petition for post-grant review is a pleading and, unlike a complaint filed in a district court, requires more than mere notice to the opposing party and Board. Although, for the reasons below, we find that Petitioner has presented evidence demonstrating that it is more likely than not that the claim of the D’986 patent is unpatentable under 35 U.S.C. § 102, we emphasize that vagueness and ambiguity in pleadings to the Board will not typically inure to the benefit of the pleading party. However, here the underlying facts bearing on anticipation and the on-sale bar are apparent on the face of the evidence presented at this stage of the proceedings. Whether Petitioner’s case under Section 102 is brought for traditional anticipation by a publically available publication or under the on-sale bar, or both, we find Petitioner’s evidence sufficient under the standard to institute post-grant review. At this stage in the proceedings we consider that Petitioner’s

Ground 1 to have been brought under 35 U.S.C. § 102(a)(1) for either anticipation, or on-sale bar, or both.

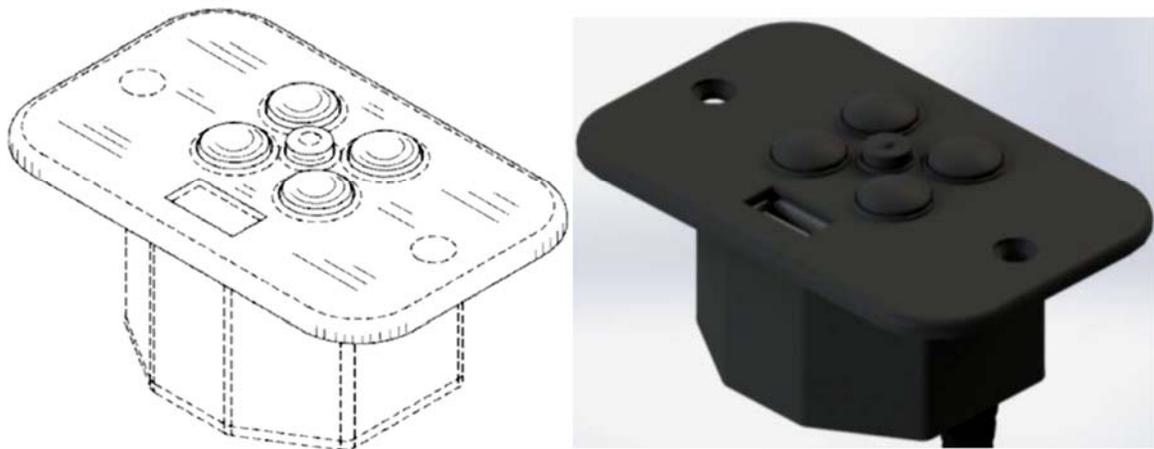
We first address Petitioner’s arguments for anticipation by the Raffel\_sample as it is described in the PDF attachment of the Song email. *See Exs. 1004 and 1005.*

Petitioner contends the Raffel\_sample is prior art to the D’986 patent, stating “Raffel\_sample qualifies as prior art because it was on sale to the public before the effective filing date of January 31, 2017 for the ‘986 patent. *See Ex. 1004, Ex. 1005 and Ex. 1010.*” Pet. 3, 8 (citing the Song email and its English translation, and the authenticating Huang Declaration as evidence). The Song email on its face indicates it was sent on November 17, 2015, which is more than a year before the D’986 patent’s filing date. Ex. 1001; Ex. 1004; Ex. 1005. The PDF attachment to the Song email describing the Raffel\_sample indicates on its face that it existed on November 16, 2015; again, more than a year before the D’986 patent’s filing date. Ex. 1004. Fact witness Linhua Huang states that he received the Song email and its PDF attachment describing the Raffel\_sample on November 17, 2015, thus corroborating its send-date noted above. Ex. 1010 ¶¶ 1–5. The Zhang Declaration states that the PDF attachment describing the Raffel\_sample indicates it was publically available on the internet before the filing date of the D’986 patent, which supports that the Raffel\_sample qualifies as a prior art publication with respect thereto. Ex. 1011 ¶¶ 25–26.

The Petition and the Zhang Declaration compare the Raffel\_sample to the claimed design of the D’986 patent. *See Pet. 23–24; Ex. 1011 ¶ 45.* Although each provides a text description of the visual features common to

both the claimed design and the Raffel\_sample, the similarities are most apparent based on simply visually comparing the two images. As has Petitioner and the Zhang Declaration, we again reproduce the D'986 patent's Figure 1 and the Raffel\_sample side-by-side below:

FIG. 1



It is readily discernable that the Raffel\_sample has, essentially, the identical design as claimed in the D'986 patent. Both the expressly claimed, solid line design features of Figure 1, and its contextual dashed-line features, are present in the Raffel\_sample, seemingly exactly as depicted in the D'986 patent.

In view of the legal standards discussed above, at this stage in the proceedings, based on the as-yet-uncontested evidence presented by Petitioner, we find the Raffel\_sample publication to be a prior art publication and to disclose a design identical in all material respects to the design claimed in the D'986 patent. Therefore, we find Petitioner has shown

it is more likely than not that the claim challenged in the Petition is unpatentable as anticipated by Raffel\_sample.

We next address Petitioner's arguments that the Song email and attached Raffel\_sample evidences an offer for sale triggering the on-sale bar under Section 102. *See* Exs. 1004 and 1005.

As noted above, the evidence (as yet uncontested) presented at this stage in the proceedings supports that the Song email and its attached Raffel\_sample were sent by Patent Owner to Petitioner on November 17, 2015, that is, more than a year before the D'986 patent's filing date of January 31, 2017. *See* Ex. 1001; Ex. 1004; Ex. 1005; Ex. 1010 ¶¶ 1–5. The Song email states as much on its face, which is corroborated by the Huang Declaration, as noted above.

Furthermore, the evidence indicates that the Song email and its Raffel\_sample attachment was not merely describing a switch meeting the claimed design, but was an offer by Patent Owner to sell the product embodying this design to Petitioner. The Song email is from Ben Song, on behalf of Raffel Systems (“Xiamen Raffel Electronic Trading Co., Ltd. (Wholly-owned subsidiary of Raffel)”), to Man Wah employees, “Manager Huang, Mr. Chen,” who appears to be Linhua Huang (“the manager of the Purchasing Department of Man Wah Group”) and J.J. Chen. Ex. 1005; *see also* Ex. 1010 ¶ 1. The Song email states: “[a]ttached you will find an offer for exclusive pricing on the CTR Series that Manwah asked about during our American leaders' visit to your company yesterday afternoon. The pricing includes shipping fees. Please take a look at your convenience.” Ex. 1005. The PDF attachment to the Song email, in relation to the Raffel\_sample,

called “Rectangular 5-Button Power Recline and Headrest with USB and Home Button CTR UR2 08,” set total pricing per unit of “67.26,” with product delivered. *Id.*

Therefore, the evidence supports that there was a concrete offer for the sale of the Rectangular 5-Button Power Recline and Headrest with USB and Home Button CTR UR2 08, which, as discussed above, has a design identical to that claimed in the D’986 patent. *See* Pet. 8. Thus, this product exemplifies a design ready for patenting. Had the Man Wah representatives so desired, it appears they could have replied to the Song email with a purchase order for this product at the offered price and that it would have subsequently been delivered upon purchase. Because the Song email predates the filing of the D’986 patent by more than a year, the on-sale bar under Section 102 applies.

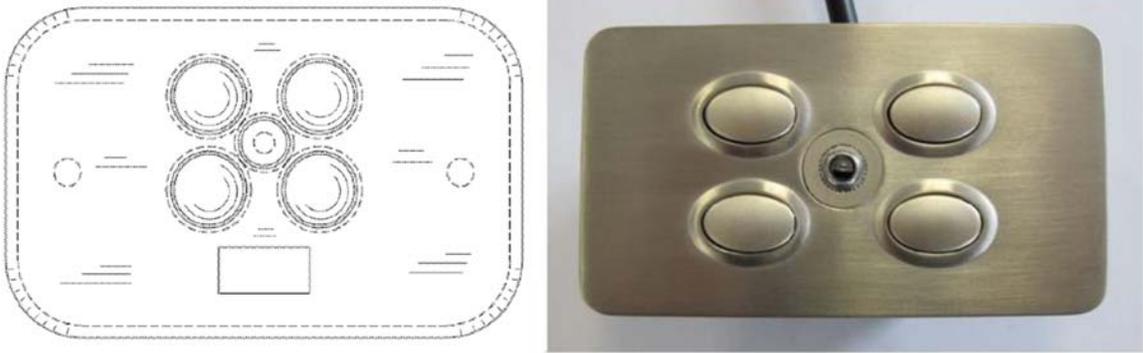
In view of the legal standards discussed above, at this stage in the proceedings, based on the as-yet-uncontested evidence presented by Petitioner, we find the Song email and its attached Raffel\_sample publication evidence an offer-to-sell triggering the on-sale bar. Therefore, we find Petitioner has shown it is more likely than not that the claim challenged in the Petition is unpatentable under Section 102.

*E. GROUND 2—OBVIOUSNESS OVER KINTEC\_SOLUTION AND HUA-DALI*

*Parties’ Positions*

Petitioner contends “Kintec\_Solution provides ‘basically the same visual impression’ as the design claimed in the '986 patent,” “[a]s illustrated [by a visual comparison of] Kintec\_Solution and the '986 patent depict[ing] a switch with buttons on a surface. Ex. 1011, ¶ 47.” Pet. 24–25. Petitioner

reproduced the D'986 patent's Figure 5 and an image of Kintec\_Solution, as follows:

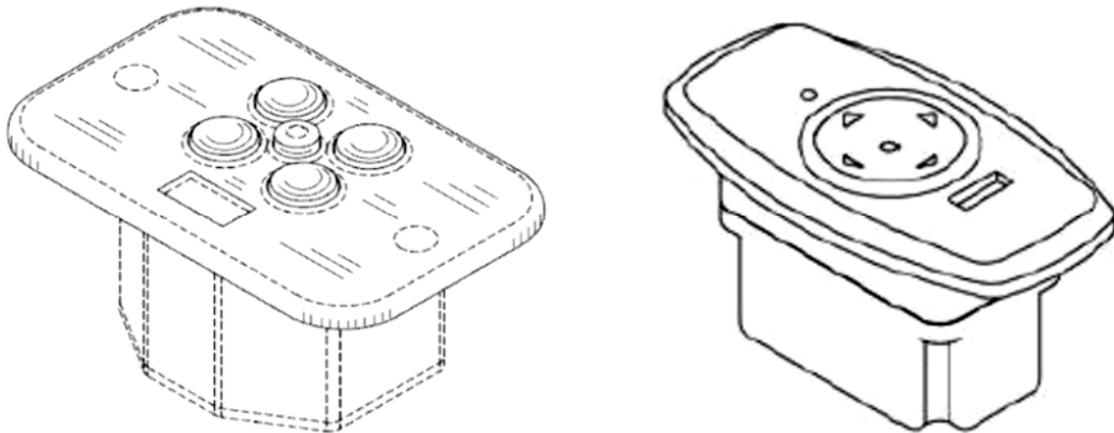


*Id.* at 25. The D'986 patent's Figure 5 is shown above-left and Kintec\_Solution image, which is a photograph of a faceplate with four centered and equally spaced in a rectangular configuration, oval-shaped buttons protruding from openings therein, surrounding some feature at the centermost point of the faceplate, is shown above-right. Ex. 1001 Figure 5; Ex. 1006, 2.

Petitioner concedes that there are design differences between the patented design and Kintec\_Solution (identifying that Kintec\_Solution's buttons are not circular and the face plate has no rectangular hole, e.g., for a USB plug), but contends that the designer of ordinary skill would nonetheless consider the two designs to create basically the same visual impression. Pet. 25–27 (citing *In re Nalbandian*, 661 F.2d 1214, 1215 (CCPA 1981)). Thus, Petitioner contends Kintec\_Solution is a primary reference, which conveys the basically the same design as claimed, but which could be modified in view of pertinent secondary references to fully teach or suggest the claimed design.

Petitioner argues it would have been obvious to add a rectangular hole on the switch as claimed in the D'986 patent in view of CN204315857 (Exhibit 1008, "CN'857"). Pet. 27–28. Petitioner contends CN'857 shows a hole in a switch face plate for a USP plug and “difference here involves merely adding a rectangular hole apart from the four-button group on the surface of a button switch.” *Id.* at 28. The CN'857 reference is not, however, expressly combined with Kintec\_Solution by Petitioner under Ground 2. CN'857 is merely cited as evidence that adding a rectangular hole would be an obvious modification to Kintec\_Solution. Petitioner does expressly combine Hua-Dali with Kintec\_Solution for the same purpose, however. Pet. 30. Petitioner contends:

Hua-Dali discloses the design of the button switch that has four outside components, one central component, and a rectangular hole on the surface that is away from the button group. Ex. 1011, ¶ 58. A comparison of the design of the '986 patent and Hua-Dali is provided below:



The D'986 Figure 1 is shown above-left and the 7<sup>th</sup> figure of Hua-Dali is shown above-right. Ex. 1007, 3. Petitioner contends “[a] DHOSITA would

have found it obvious to add the rectangular hole on the surface taught by Hua-Dali in the design of the primary reference Kintec\_Solution. Ex. 1011, ¶ 59.” Pet. 31 (citing Zhang Declaration ¶ 59).

As for the differently shaped buttons of the Kintec\_Solution compared to the claimed design, Petitioner contends:

A DHOSITA would have found it obvious to alter the oval shaped buttons of Kintec\_Solution to different shapes. Ex. 1011, ¶ 55. Both the oval shaped button and the circular button are rounded buttons. *Id.* As such, the circular rounded button for a switch is a *de minimis* obvious design variation of Kintec\_Solution. *Id.* Accordingly, it would have been immediately apparent and well within the knowledge and skill of a DHOSITA to alter the oval shaped buttons in Kintec\_Solution to arrive the claimed design of the '986 patent. *Id.*

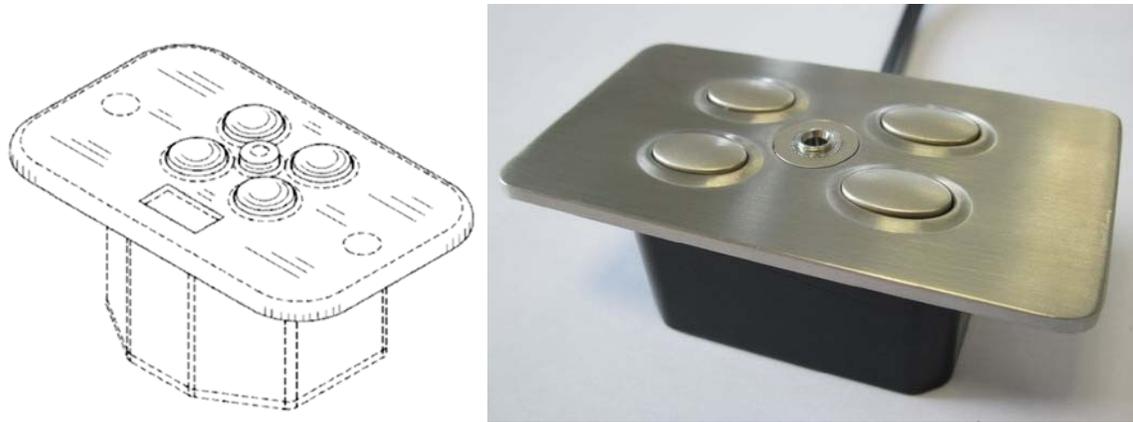
Pet. 29.

As noted above, Patent Owner has not provided a substantive response to Petitioner’s contentions at this stage in the proceedings.

#### *Analysis*

Although the Zhang Declaration supports Petitioner’s contention that Kintec\_Solution provides basically the same visual impression as the claimed design, we find that it does not. We visually compare the second image of Kintec\_Solution to Figure 1 of the D’986 patent and reproduce them side-by-side below:

FIG. 1



Ex. 1001, Fig. 1; Ex. 1006, 1. The D'986 patent's Figure 1 is shown above-left and the second image of Kintec\_Solution is shown above-right.

Visually comparing the two above designs, we find several significant differences, which, considering the two designs each as a whole, illustrate that the Kintec\_Solution design is not basically the same as the claimed design. We discuss these differences below.

The shape of the faceplate portion of the two designs is not the same. The claimed design shows more rounded corners than the Kintec\_Solution design and the claimed design's face plate has a rounded-beveled edge, while the Kintec\_Solution's faceplate has straight-sided edges. The dominant button-like features of the claimed design are shown as not only circular, but domed. The buttons of Kintec\_Solution, conceded by Petitioner to not be circular, also do not appear to be domed as in the claimed design. The claimed design includes a central button-like feature having the same overall elevation as the surrounding four, larger button-like features, but is smaller and has a straighter edged perimeter than the surrounding four

buttons. It is unclear what the central-most feature shown in Kintec\_Solution is, but it does not appear to be a button or button-shaped and is certainly not shaped like the respective feature of the claimed design. Before even considering the lack of a rectangular hole, we find these difference to be significant enough that Kintec\_Solution does not show the same basic design as the claimed design so as to be a proper primary reference.

Even were Kintec\_Solution a proper primary reference, we also find that it would not have been obvious to modify its design to have a rectangular opening like the claimed design, e.g. for a USB plug. Petitioner bases the proposed modification to Kintec\_Solution's design on the drawings of Hua-Dali; however, the Hua-Dali design does not position its rectangular opening similarly to the claimed design. Rather than position the rectangular opening along a long-edge of the face plate, so that its configuration with the five button-like features is centrally located on the faceplate feature, as claimed, Hua-Dali positions its rectangular opening more along a short-edge of its face plate, which is a 90° rotation of the rectangular opening respective of the claimed design and along a different side of the operational buttons' configuration from the claimed design. Thus, even were Kintec\_Solution and Hua-Dali properly combined, the result would not be the claimed design. We see no reason why it would have been obvious to alter the proposed Kintec\_Solution-Hua-Dali combination further to achieve the claimed design.

In view of the legal standards discussed above, at this stage in the proceedings, based on the as-yet-uncontested evidence presented by

Petitioner, we find the Kintec\_ Solution and Hua-Dali combination would not have rendered the claimed design obvious. Therefore, we find Petitioner has not shown it is more likely than not that the claim challenged in the Petition is unpatentable under Section 103.

### III. CONCLUSION

On the record before us at this stage in the proceeding, Petitioner has demonstrated it is more likely than not that the claim challenged in the petition is unpatentable under Ground 1. Our decision at this stage derives from our preliminary review of the challenged claim, the asserted prior art, and the opinion and facts set forth in the as-yet-unrebutted Declarations.

In accordance with the Court’s decision in *SAS* (138 S. Ct. at 1359–60) and Office guidance,<sup>6</sup> we institute a post-grant review of the challenged claim of the D’986 patent on both grounds alleged by Petitioner.

Nevertheless, this decision does not reflect a final determination on the patentability of any claim. We further note that the burden remains on Petitioner to prove unpatentability of each challenged claim. *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015).

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<sup>6</sup> Guidance on the Impact of SAS on AIA trial proceedings (Apr. 26, 2018), accessible at <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/trials/guidance-impact-sas-aia-trial> (last accessed Oct. 2, 2018) (“At this time, if the PTAB institutes a trial, the PTAB will institute on all challenges raised in the petition,” and “for pending trials . . . , the panel may issue an order supplementing the institution decision to institute on all challenges raised in the petition.”).

ORDER

Accordingly, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 324, a post-grant review of the claim of the D'986 patent, in accordance with each ground on which the challenge to each claim is based in the Petition, is hereby *instituted*; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 324(c) and 37 C.F.R. § 42.4(b), post-grant review of the D'986 patent will commence on the entry date of this Order, and notice is hereby given of the institution of a trial.

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For PETITIONER:

Shen Wang  
Hao Tan  
ARCH & LAKE LLP  
shenwang@archlakelaw.com  
haotan@archlakelaw.com

For PATENT OWNER:

David A. Casimir, Ph.D.  
Tyler J. Sisk, Ph.D.  
CASIMIR JONES S.C.  
docketing@casimirjones.com  
dacasimir@casimirjones.com  
tjsisk@casimirjones.com